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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Masaaki Noro

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STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

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EXAMINER

HALIM, SAHERA

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/993,498	<b>Applicant(s)</b> NORO ET AL.	
	<b>Examiner</b> SAHERA HALIM	<b>Art Unit</b> 2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2457

### DETAILED ACTION

1. This action is responsive to RCE filed on March 3, 2009.
2. Claims 1-18 have been cancelled.
3. Claims 19-27 are pending.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 19, 20, and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner fails to find support “for enabling only the first communications terminal to identify” and “enabling only the second communication terminal”.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d* mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph. **2173.05(j)**

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 19-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Petty et al. US Patent No. 6,337,858. Petty teaches the invention as claimed including a method for providing direct mode communication between two mobile terminals (see abstract).

8. As per claims 19-22, Petty teaches a communications control method, a communications terminal, a computer readable medium, and a communications control computer product utilized by a first communications terminal T1

Art Unit: 2457

connectable via a network and via a firewall with a second communications terminal T2, the communications control method, terminal, function, and program for executing including:

reporting to the second communications terminal T2 first session identification information S1 and a second terminal identifier of the second communication terminal T2 (IP address sent after request, Figure 6; column 4, lines 45-67; column 9, lines 40-67);

the first session identification information S1 enabling only the first communications terminal T1 to identify communications between the second communications terminal T2 and the first communications terminal T1 (Figure 6 and Figure 7, column 10, lines 9-40);

the first session identification information S1 being determined by the first communications terminal T1, so as to be unique only at the first communications terminal T1; (column 10, lines 20-35); and

the second terminal identifier identifying the second communications terminal T2 (column 10, lines 35-40);

receiving from the second communications terminal T2 second session identification information S2 and a first terminal identifier (column 11, lines 5-40);

the second session identification information S2 enabling only the second communications terminal T2 to identify communication between the first communications terminal T1 and the second communication terminal T2 (column 11, lines 6-40); and

Art Unit: 2457

a first terminal identifier identifying the first communications terminal T1 (column 20, lines 5-40); and

communicating with the second communications terminal T2 by carrying out transmission and reception of data containing the first session identification information S1 and second session identification information S2, the first terminal identifier, and the second terminal identifier between the first communications terminal T1 and the second communications terminal T2 (Figures 6-9, column 10, lines 9-40).

9. As per claim 23, Petty teaches a communications method for when, via a secure host defending against wrongful access from without, internal terminal devices connected to a network on the inside of the secure host and external terminal devices connected to a network on the outside carry out voice communications, the communications method characterized by:

accepting by way of the secure host, from outside the secure host, a call request from an external terminal device to a connectable internal terminal device, or accepting by way of the secure host, from inside the secure host, a call request from an internal terminal device to a connectable external terminal device (column 9, lines 40-67);

when a call between the external terminal device and the internal terminal device is established, reporting to the two terminal devices a path readied in advance for transmitting and receiving voice data, and session identification information for distinguishing what is voice data between the terminal devices,

Art Unit: 2457

and meanwhile storing terminal-device information identifying the two terminal devices, correlatively with the session identification information reported to the two terminal devices (column 10, lines 9-40);

when the secure host has received form the external terminal device or the internal terminal device voice data containing the session identification information, specifying, from the terminal-device information stored correlatively with the session identification information, a communications-destination terminal device for the voice data, and sending out received voice data to the specified terminal device (column 11, lines 4-47) .

10. As per claim 24, Petty teaches the communications control method of claim 19, wherein the receiving-port number and the sending-port number are reported in addition to the session identification in a reporting step (column 10, lines 10-25; column 13, lines 43-47).

11. As per claim 25, Petty teaches the communications control method of claim 19, wherein a communications identifier is reported together with the session identification information in a communications step (information and request; column 9, lines 10-45).

12. As per claim 26, Petty teaches the communications control method of claim 19, wherein the session identification information is generated based on the terminal identifier of the communications terminal (column 10, lines 5-25).

13. As per claim 27, Petty teaches the communications control method of claim 19, wherein the session identification information is generated by a random number generator (column 13, lines 26-67).

**It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonable suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968))**

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAHERA HALIM whose telephone number is (571)272-4003. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2457

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sahera Halim  
Patent Examiner

/ARIO ETIENNE/  
Supervisory Patent Examiner, Art Unit 2457